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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,602	01/22/2004	John W. Barrus	20412-08763	7263
758 7590 05/31/2007 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER VU, KIEU D	
			ART UNIT 2173	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,602	Applicant(s) BARRUS ET AL.	
	Examiner Kieu D. Vu	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2173

DETAILED ACTION

1. This Office Action is responsive to the Preliminary Amendment filed on 04/05/04.
2. Claims 6-36 are pending.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 6, 13, 14 are respectively rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 12, and 3 of U.S. Patent No. 6, 693, 652. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6, 13, 14 of the instant application are anticipated, respectively, by claims 2, 12, and 3 of U.S. Patent No. 6, 693, 652.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 25-36 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.

Regarding claim 25, although the preamble of the claim recites "an apparatus", the body of the claim includes only software programs such as "software application", "image capture module", "reference determination module", "object creation module". Claim 25 neither includes any computer hardware component(s) nor positively recites that the cited software programs are stored on a computer medium that can be read by a machine. As such, claim 25 is directed to software per se which is non-functional descriptive material and non-statutory.

Claims 26-36 are also directed to software per se which is non-functional descriptive material and non-statutory based on the same rationale set forth above.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before

the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 6-7, 17-20, 25-26, and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Anguilo et al (US 6,275, 839).

Regarding claims 6 and 25, Anguilo teaches a method and an apparatus for creating a representation of a first object (creating a thumbnail of an original image) (step 104 in Fig. 4), the first object associated with a first software application (software application to create thumbnail), the method comprising: capturing an image of the first object (creating a thumbnail of an original image) (step 104 in Fig. 4); determining a reference to the first object (adding link attribute in step 124 in Fig. 4); and creating a second object (creating a modified web page that includes the thumbnail) (steps 120 and 122 in Fig. 4), the second object associated with a second software application (software application to replace the full size image 10 with the thumbnail image 12 in the web page 146) (Fig. 6 and 7) , the second object comprising the captured image and the determined reference (web page 146' includes thumbnail 12 and the link associated with the thumbnail) (Fig. 7-8) (col. 12, lines 19-38).

Regarding claims 7 and 26, Anguilo teaches claims 6 and 25, wherein the first object is displayed in the first software application and wherein capturing the image of the first object comprises capturing the image of the first object as displayed in the first software application (Fig. 6).

Regarding claims 17 and 35, Anguilo teaches claims 6 and 25, further comprising storing the first object in a memory and wherein determining the

Art Unit: 2173

reference to the first object comprises producing a pointer to the first object in the memory (col. 9, lines 5-16),

Regarding claims 18 and 36, Anguilo teaches claims 6 and 25, further comprising prior to capturing the image of the first object, receiving an input from a user, the input selecting the first object (col. 5, lines 61-66).

Regarding claim 19, Anguilo teaches the method of claim 6, further comprising: receiving an input from a user, the input selecting the second object; and responsive to having received the input, displaying the first object (col. 12, lines 19-38).

Regarding claim 20, Anguilo teaches the method of claim 18, wherein the first object comprises a hypertext link and wherein displaying the first object comprises: determining whether a web page corresponding to the hypertext link is accessible; responsive to having determined that the web page is accessible, presenting the web page; and responsive to having determined that the web page is not accessible, presenting a web page that corresponds to the hypertext link and is stored in memory (line 61 of col. 5 to line 9 of col. 6).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8, 10, 12, 14-16, 27, 29, 30, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anguilo and Chailleux (US 6,404,441).

Regarding claims 8 and 27, Anguilo teaches claims 7 and 26 but does not teach wherein capturing the image of the first object as displayed in the first software application comprises capturing a screen shot of the first object as displayed in the first software application. Chailleux teaches capturing screen shot of displayed screens and displayed captured screen shots as reduced images (col. 9, lines 9-24, Fig. 6). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo and Chailleux before him at the time the invention was made, to modify the capturing system taught by Anguilo to include capturing screen shot taught by Chailleux with the motivation being to enable Anguilo's system to embed different types of images in a web page.

Regarding claims 10 and 29, Anguilo teaches claims 6 and 25 but does not teach wherein the first object represents a plurality of images and wherein capturing the image of the first object comprises capturing one of the plurality of images represented by the first object. Chailleux teaches capturing the image of the first object comprises capturing one of the plurality of images represented by the first object (capturing screen shot of displayed screens and displayed captured screen shots as reduced images, col. 9, lines 9-24, Fig. 6). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo and Chailleux before him at the time the invention was made, to modify the capturing system taught by Anguilo to include capturing screen shot taught by Chailleux with the motivation being to enable Anguilo's system to embed different types of images in a web page.

Regarding claims 12 and 30, Anguilo teaches claims 6 and 25 but does not teach wherein the first object represents a web page and wherein determining the reference to the first object comprises determining a Uniform Resource Locator (URL) of the web page. Chailleux teaches capturing a web page (col. 12, lines 30-47). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo and Chailleux before him at the time the invention was made, to modify the capturing system taught by Anguilo to include capturing web page taught by Chailleux with the motivation being to enable Anguilo's system to embed different types of images in a web page.

Regarding claims 14, 16, 32, and 34, Anguilo teaches claims 6 and 25, but does not teach wherein the first object comprises a hypertext link and wherein capturing an image of the first object comprises capturing an image of a web page corresponding to the hypertext link. Chailleux teaches capturing a web page displayed in a web browser (col. 12, lines 30-47). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo and Chailleux before him at the time the invention was made, to modify the capturing system taught by Anguilo to include capturing web page taught by Chailleux with the motivation being to enable Anguilo's system to embed different types of images in a web page.

Regarding claims 15 and 33, Anguilo, as modified by Chailleux teaches storing the web page in a memory (Chailleux, col. 9, lines 8-17).

11. Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anguilo and Junglieb (US 5,886,274)

Regarding claims 9 and 28, Anguilo teaches claims 6 and 25 but does not teach wherein the first object represents a sound and wherein capturing the image of the first object comprises generating a waveform for the sound represented by the first object. Jungleib teaches a sound editor for generating a waveform for the sound represented by the first object (col. 5, lines 38-41, Fig. 4b). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo and Jungleib before him at the time the invention was made, to modify the capturing system taught by Anguilo to include generating a waveform of a sound taught by Jungleib with the motivation being to enable Anguilo's system to embed different types of objects in a web page.

12. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anguilo, Chailleux, and Jungleib.

Regarding claim 11, Anguilo and Chailleux teach the method of claim 10 but do not teach wherein the first object represents a sound. Jungleib teaches a sound editor for generating a waveform for the sound represented by the first object (col. 5, lines 38-41, Fig. 4b). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo, Chailleux, and Jungleib before him at the time the invention was made, to modify the capturing system taught by Anguilo to include generating a waveform of a sound taught by Jungleib with the motivation being to enable Anguilo's system to embed different types of objects in a web page.

13. Claims 13, 21-24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anguilo and Treibitz (US 6,091,408).

Regarding claims 13 and 31, Anguilo teaches claims 6 and 35, but does not teach wherein the first object represents a message and wherein determining the reference to the first object comprises determining a pointer to the message in a messaging system. Treibitz teaches wherein the first object represents a message and wherein determining the reference to the first object comprises determining a pointer to the message in a messaging system (col. 5 lines 33-47). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo and Treibitz before him at the time the invention was made, to modify the capturing system taught by Anguilo to include capturing message taught by Treibitz with the motivation being to enable Anguilo's system to embed different types of objects in a web page.

Regarding claim 21, Anguilo does not teach updating the second object. Treibitz teaches updating the second object (window in the second display, col. 2, line 67 to col. 3, lines 14). It would have been obvious to one of ordinary skill in the art, having the teaching of Anguilo and Treibitz before him at the time the invention was made, to modify the capturing system taught by Anguilo to include updating the second object taught by Treibitz with the motivation being to provide Anguilo's system with the ability to modify the second object.

Regarding claim 22, Anguilo, as modified by Treibitz, teaches the method of claim 21, wherein updating the second object comprises: capturing a new image of the first object; and replacing, within the second object, the image with the new image (Treibitz, col. 3, lines 4-15).

Regarding claim 23, Anguilo, as modified by Treibitz, teaches the method of

claim 21, wherein updating the second object comprises: determining a new reference to the first object; and replacing, within the second object, the reference with the new reference (Treibitz, col. 3, lines 4-15).

Regarding claim 24, Anguilo, as modified by Treibitz, teaches the method of claim 21, wherein updating the second object comprises: determining whether the first object has changed; and responsive to having determined that the first object has changed, updating the second object (Treibitz, col. 3, lines 4-15).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

and / or:

571-273-4057 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

Art Unit: 2173

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kieu D. Vu

Primary Examiner